

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH R. PARADIS

Appeal No. 2001-2363
Application 09/073,022

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for appropriate action with regard to the items listed below.

1. Independent claim 21 on appeal stands rejected under 35 U.S.C. § 102(b) as being anticipated by Brony (U.S. Patent No. 5,620,434). On page 13 of the revised brief filed March 5, 2001

(Paper No. 14) appellant has pointed to the language of claim 21, particularly the limitation in the last clause of the claim, and argued that "[t]here is no slidable movement of a plug through a bore in Brony." In the examiner's answer (Paper No. 15, mailed March 29, 2001) the examiner has responded (at page 6) by urging that a limitation with regard to slidable movement of the plug is "not recited in the rejected claim(s)." We are somewhat puzzled by this position, since although claim 21 as it appears in Appendix A of appellant's revised brief does not include this limitation, a review of the file record shows that claim 21 as amended in Paper No. 5, filed December 28, 1999, does include this limitation. Thus, we remand for the examiner to provide a correct copy of the claims on appeal and to permit the examiner an opportunity to consider and respond to appellant's argument with respect to the "slidable movement" limitation in claim 21.

2. Independent claim 30 also stands rejected under 35 U.S.C. § 102(b) as being anticipated by Brony (U.S. Patent No. 5,620,434). Our problem in this instance relates to clause (b) of claim 30, i.e., "extending a plug into said bore from a position sealing said outer surface of said stopper". It is not entirely clear to us what the term "extending" means in the

context of this method step. Is this an assembly step for placing or moving the plug into a given position in the stopper throughbore, or does this limitation set forth a structural feature of the plug, i.e. that the plug has a portion which extends into the throughbore from a position sealing the outer surface of the stopper?

In the context of the examiner's rejection, we note that the examiner has indicated (answer, page 6) that Brony (e.g., Figs. 7 & 8) discloses this limitation. However, the examiner has provided no explanation of exactly how the structure and method taught in Brony would meet this limitation. In that regard, it does not appear to us that in either Figure 7 or Figure 8 of Brony the element (72), referred to by the examiner as corresponding to the "plug," has any sealing engagement with an outer surface of the stopper. We therefore remand for clarification of the examiner's rejection under 35 U.S.C. § 102(b) and for an explanation of exactly how claim 30 would be readable on Brony.

3. In addition, we make note of the examiner's position in the answer regarding the rejection of claim 25 under 35 U.S.C. § 103(a) based on Brony. This claim sets forth the step of providing the plug of claim 21 with "a non-planar external surface." The examiner has urged (answer, pages 7-8) that this limitation is "a matter of mere obvious routine design choice," and directed appellant's attention to "any of the enclosed references which illustrate a plug insert of a vial stopper to see this common, old and well known feature in the prior art." However, by referring to the "enclosed references" in support of the rejection of claim 25 the examiner has now relied upon evidence not set forth in the statement of the rejection. If the examiner is of the view that certain of the "enclosed references" should have been relied upon to support the rejection, then they should be applied and must appear in the statement of the rejection. We remand for the examiner to clarify whether the other "enclosed references" are being relied upon and, if so, to take appropriate action.

In viewing claim 25, we would agree with the examiner that it would appear the "external surface" of the plug as recited in the claim encompasses all of the external surfaces of the plug

(i.e., top, sides, and bottom), and not just that portion of the plug exposed on the exterior of the stopper. Note, in this regard, that appellant's plug has ribs (e.g., 21 or 210) on the external surface thereof, as well as protrusions (e.g., 32-1 through 32-4 or 320-1 through 320-4) on its upper external surface (e.g., 31 or 310). Moreover, we observe that if the valve body (72) of Brony seen in Figures 7 and 8 is cylindrical, then that would appear to satisfy the broad recitation of claim 25.

4. With respect to the examiner's rejection of claim 22 under 35 U.S.C. § 102(b) based on Brony, we note that appellant has made an argument on page 13 of the brief concerning a specific limitation in this claim not being found in the applied reference. The examiner's answer makes no response to this argument and does not otherwise mention claim 22. Thus, we are at a loss to see exactly how the examiner intends to read this claim on Brony. On remand, we solicit some explanation from the examiner as to how the limitations of claim 22 are met by Brony.

5. As an additional item, we note that the examiner has indicated on page 8 of the answer that claim 26 has been

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"designated as allowable," but then proceeds to assert that "the specification as currently written does not fully support the subject matter language of the claim" This latter statement would appear to raise a question under 35 U.S.C. § 112, first paragraph, or under 37 CFR § 1.75(d)(1) which have not been otherwise addressed by the examiner. Clarification is required.

In considering claim 26, we commend to the examiner's attention the disclosure at page 8, lines 1-5 of the specification and also that of Figures 8A through 8D, noting that the "engaging" and "piercing" steps set forth in claims 21 and 26, respectively, need not be performed in any particular order.

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This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND TO THE EXAMINER

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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